

REMARKS

Applicants respectfully request reconsideration and allowance in view of the following remarks. Applicants note that while a declaration was prepared in combination with the response filed 23 March 2009, the declaration was inadvertently omitted. Applicants submit the declaration with Exhibits A and B and reiterate substantially the same arguments as previously presented.

Rejection of Claims 37, 38 and 50-63 Under 35 U.S.C. §102(e)

The Office Action rejects claims 37, 38 and 50-63 under 35 U.S.C. §102(e) as being anticipated by Rui et al. in view of Sezan et al. Applicants are confused and request clarification of this rejection because it appears to be a §103 rejection, but the rejection is presented under §102(e) with multiple references. While MPEP 2131.01 states that a 35 U.S.C. §102 rejection over multiple references can be proper in three situations, none of these situations are present. The three situations are when the extra references are cited to (A) Prove the primary reference contains an "enabled disclosure;" (B) Explain the meaning of a term used in the primary reference; or (C) Show that a characteristic not disclosed in the reference is inherent. The Examiner has not indicated which, if any, of these three situations this rejection falls under and none of the rejection grounds appear to fall under any of these three situations. For this reason Applicants also request that the Office Action be made non-final. However, in order to further prosecution, Applicants proceed to treat the rejection as if it were under 35 U.S.C. §103.

Applicants do not acquiesce that it would have been obvious to one of skill in the art to combine Rui et al. with Sezan et al. However, Applicants do not at this time argue against their combination because as explained below and as set forth in the accompanying declaration Rui et al. is not available as prior art under 35 U.S.C. §102(e).

Affidavits or declarations under 37 C.F.R. §1.131 may be used, for example, to antedate a reference that qualifies as prior art under 35 U.S.C. §102(e). MPEP 715.I.B. The Office Action rejects claims 37, 38, and 50-63 under 35 U.S.C. §102(e) as being anticipated by Rui et al. and Sezan et al. Therefore, a declaration under 37 C.F.R. §1.131 may antedate Rui et al. Applicants submit a declaration to that effect. However, Applicants were unable to reach two of the inventors, Vijay Bhagavath and Joseph Thomas O'Neil, after diligent effort. Applicants submit a statement of facts describing the diligent effort made to contact Vijay Bhagavath and Joseph Thomas O'Neil, as set forth in MPEP 409.03(d)(I). Briefly, the statement of facts outlines the individual steps Applicants have taken in an attempt to contact Vijay Bhagavath and Joseph Thomas O'Neil. After endeavoring to contact the inventors electronically and via phone, Applicants have expended diligent effort to find the inventors, but have been unable to locate them. Accordingly, Applicants submit the statement of facts as well as the declaration under 37 C.F.R. §1.131 with the signature of Robert Edward Markowitz, the only inventor Applicants could locate.

Applicants herein set forth the timeline found in the declaration to establish a date of invention prior to the effective 102(e) date of Rui et al. 35 U.S.C. §102(e), allows for U.S. patents and U.S. patent application publications to be applied against the claims as of their effective U.S. filing dates. MPEP 706.02(f). Rui et al. is a divisional of Application No. 09/660,529 filed Sep 13, 2000, now issued as U.S. Patent No. 7,028,325, which claims priority from provisional application 60/153,730 filed Sep 13, 1999, making this Rui et al.'s effective U.S. filing date.

This application is a continuation of application no. 09/577,642, now issued as U.S. Patent No. 6,829,781, filed May 24, 2000. The declaration offers evidence that Applicants conceived of the invention prior to Rui et al.'s filing date of 13 Sep 1999. The first piece of

evidence is an internal patent review document dated 13 Aug 1999 which substantially describes the invention. Declaration, Exhibit A. The second piece of evidence is an email dated 23 Aug 1999 from inventor Vijay Bhagavath to Joyce Burns for patent review. Declaration, Exhibit B. These two documents show that Applicants conceived of the invention prior to Rui et al.'s filing date. Further, Applicants were diligent in reducing the invention to practice up to Rui et al.'s filing date by submitting the invention for internal AT&T review and preparation of the patent application. The diligence of attorney in preparing and filing patent application inures to the benefit of the inventor. MPEP 2138.06. The prompt filing of the application, only 9 months from the initial disclosure, is evidence of attorney diligence.

Accordingly, Applicants submit that the evidence in the declaration establishes a date of conception prior to the filing date of Rui et al. and further submit that Rui et al. is not available as prior art under 35 U.S.C. §102. Applicants therefore respectfully request that the 35 U.S.C. §102(e) rejection be withdrawn.

Rejection of Claims 32, 50 and 59 Under 35 U.S.C. §101

The Office Action rejects claims 32, 50 and 59 under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Applicants amend claims 32 and 50 to recite computer-implemented methods. Claims 32 and 50 now recite a practical, useful application of the method that is tied to a computer implementation. Claims 32 and 50 produce a useful, tangible, and concrete result of streaming summary segments and program segments from a network node to a client device. The claims provide a useful result from the perspective of the client device which receives prepared summary segments and program segments.

Applicants amend claim 59 to recite a system comprising a processor and various means for controlling the processor to perform certain acts. Claim 59 now excludes non-patentable

embodiments, such as pure software or an electronic signal. Claim 59 further produces a useful, tangible, or concrete result of controlling the processor to stream prepared summary segments and program segments from the system to a client device. Accordingly, Applicants submit that claims 32, 50, and 59 are directed to patentable subject matter and respectfully request that the 35 U.S.C. §101 rejection be withdrawn.

Rejection of Claims 32-36, 39 and 40-43 Under 35 U.S.C. §103(a)

The Office Action rejects claims 32-36, 39 and 40-43 under 35 U.S.C. §103(a) as being unpatentable over Sezan et al. (U.S. Patent No. 6,236,395) (“Sezan et al.”) in view of Rui et al. (U.S. Patent Publication No. 2005/0160457) (“Rui et al.”). Applicants traverse this rejection. Applicants do not acquiesce that it would have been obvious to one of skill in the art to combine Rui et al. with Sezan et al. and reserve the right to argue against their combination.

Applicants submit that the declaration establishes a date of conception prior to the filing date of Rui et al. and further submit that Rui et al. is not available as prior art under 35 U.S.C. §102. Subject matter that is prior art under 35 U.S.C. §102 can be used to support a rejection under section 103. *Ex parte Andresen*, 212 USPQ 100, 102 (Bd. Pat. App. & Inter. 1981). MPEP 2141.01 (I). However, because Rui et al. is not available as prior art under 35 U.S.C. §102, as set forth above, Rui et al. is also not available as prior art under 35 U.S.C. §103. Without Rui et al., the proposed combination of references does not teach the limitations of claim 32 as well as dependent claims 33-36, 39, and 40-43. Accordingly, Applicants respectfully request that the 35 U.S.C. §103(a) rejection be withdrawn.

Rejection of Claims 44-49 Under 35 U.S.C. §103(a)

The Office Action rejects claims 44-49 under 35 U.S.C. §103(a) as being unpatentable over Sezan et al. in view of Seidman et al. (U.S. Patent No. 6,298,482) (“Seidman et al.”). Applicants traverse this rejection. Applicants do not acquiesce that it would have been obvious to one of skill in the art to combine Sezan et al. with Seidman et al. and reserve the right to argue against their combination.

Applicants note that claims 44-49 depend from and include the limitations of claim 32. Applicants further note that this rejection does not include Rui et al. which was cited against claim 32 and asserted as teaching one of the limitations of claim 32. Applicants respectfully submit that this 35 U.S.C. §103(a) rejection is invalid inasmuch as the cited combination of references does not teach all the limitations of claims 32, which are incorporated into claims 44-49, namely that the summary segments are streamed in a first channel to the client device. However even if the Office Action included Rui et al. in this rejection as Applicants presume was intended, Applicants submit that claims 44-49 are still patentable. Subject matter that is prior art under 35 U.S.C. §102 can be used to support a rejection under section 103. *Ex parte Andresen*, 212 USPQ 100, 102 (Bd. Pat. App. & Inter. 1981). MPEP 2141.01 (I). However, because Rui et al. is not available as prior art under 35 U.S.C. §102, as set forth above, Rui et al. is also not available as prior art under 35 U.S.C. §103. Without Rui et al., the proposed combination of references does not teach the limitations of claims 44-49 inherited from claim 32. Accordingly, Applicants respectfully request that the 35 U.S.C. §103(a) rejection be withdrawn.

CONCLUSION

Having addressed all rejections and objections, Applicants respectfully submit that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited. If necessary, the Commissioner for Patents is authorized to charge or credit the **Novak, Druce & Quigg, LLP, Account No. 14-1437** for any deficiency or overpayment.

Respectfully submitted,

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By: 

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